

Remarks:

Claim 1 was rejection under § 103 based on the patent to Russo. The claim *inter alia* calls for a controller to receive "a request to pause the play of said video and automatically request a code to enable video play to be resumed at a later time".

The total disclosure relating any type of pause feature set forth in the Russo patent is as follows:

In the event that the individual cannot finish a particular program once selected for enjoyment, in a further alternative embodiment, the system will keep track of exactly where the operator left off and pick up at that point without an additional charge, thus ensuring that an operator is not charged twice for selecting the same program more than once.

See column 11, lines 14-20.

Thus, all that Russo teaches is the functional idea of being able to suspend the playback and resuming without charge. Russo does not say a thing about how to do it.

Nonetheless, the Examiner states that:

It would therefore have been obvious to consider such a feature as a pause function whereby the controller 150 would recognize this command by an inherent code, as a separate command from a resume or play command, thereby meeting claims 1 and 14.

In effect, the Examiner's statement amounts to nothing more than an admission that Russo does not teach the elements of claim 1 but that they would be obvious in the absence of any supporting prior art.

To the extent that the Examiner is intending to argue that the claimed features are inherent, it is respectfully submitted that the M.P.E.P. makes it very clear that no other permissible operation must be possible with the claimed invention other than that claimed. In other words, for the reference to inherently

teach the feature, it is not sufficient that it permissibly operate in such a fashion, it must necessarily so operate. See M.P.E.P. § 2112 at pp. 2100-40.

Here, claim 1 calls for a controller to "automatically request a code to enable video play to be resumed at a later time". There is absolutely nothing in the Russo patent which in any way suggests automatically requesting a code to enable video play to be resumed.

Moreover, the feature can not be inherent because there must be a large number of ways to implement a pause feature many of which do not involve automatically causing a controller to automatically request a code.

We are left with a rejection with absolutely no prior art support for at least one missing element. Therefore, reconsideration is respectfully requested.

Claim 4 was amended to include the limitation that the controller automatically transmits an acknowledgement code to a receiver in response to a request for a code to enable the play of video to be paused and to be resumed at a later time. Thus, claim 4 covers the situation where the transmission system includes a controller that transmits decryption information to receivers, and receivers request a code to enable play of video to be paused, and the transmitter automatically provides such a code. Again, no such feature is taught by Russo which merely mentions the idea of a pause feature but provides no information about how to implement one.

Since the amendment to claim 4 adds substantially the same subject matter previously pending in the dependent claim, entry of this amendment is appropriate in response to a final rejection.

Similarly, claim 10 has been amended to include the subject matter of a dependent claim, namely "receiving an

acknowledgement code and using said acknowledgement code to resume the play of video". This claim covers the receiving end of a method in which an acknowledgement code is requested to enable pause and the acknowledgement code is provided from a remote source. All that Russo teaches is keeping track of where the user stopped watching the program. It does not say how the user is able to resume. For example, the user may be required to call up the service provider and request permission to resume.

Similarly, claim 14 has been amended to include the subject matter previously contained in the dependent claim. Thus, claim 14 calls for enabling the user to press button to resume the play of the video and in response to operation of the button, automatically transmit a code to enable the resume play of said video. Again, there is no teaching of any kind of button or button operation in Russo. Moreover, there is no teaching of any type of feature which automatically transmits the code to enable resumed play of video.

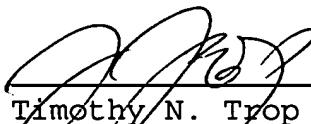
A similar analysis leads to a finding of patentability of the remaining independent claims. Therefore, reconsideration of the rejection is respectfully requested.

Therefore, the claimed invention patentably distinguishes over the art of record.

Respectfully submitted,

Date: \_\_\_\_\_

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